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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,650	12/03/2001	Shell S. Simpson	10008254-1	7559

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EXAMINER

DIVINE, LUCAS

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/998,650	Applicant(s) SIMPSON ET AL	
	Examiner Lucas Divine	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/7/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings were received on 2/13/02. These drawings are accepted.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 – 7 and 15 – 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Webb et al. (US 5727135).

Regarding claim 20, Webb teaches a **printing system (Fig. 1) comprising:**

(a) a printer (16, Fig. 1) having at least one user input key (40a-d, 45, 46, Fig. 1); and

(b) a computer (11, Fig. 1) connected to the printer over a network (21), the

computer including:

(b.1) apparatus for transmitting a print job to a printer (discussed throughout and operations performed on print jobs; col. 8 line 57 [transfer]; col. 10 line 1);

(b.2) apparatus for automatically displaying on the computer an image (Fig. 1, 35') **of the input key (40a-d', 45', 46') while the printer is processing the print job** (the status and control of the print job imply controlling the print job while it is being processed); and

(b.3) apparatus for responding to a selection of the image by causing the printer to perform a pre-determined function (col. 3 lines 55-67, col. 10 lines 60-67, Fig. 4, 200, col. 4 lines 5-9).

Regarding claim 21, which depends from claim 20, Webb teaches that one of the functions that the panels perform is a **cancel** function in col. 2 line 59, as well as the stop function in Table I (col. 10) appears to perform the canceling function.

Regarding claim 22, which depends from claim 20, Webb teaches **the printer is configured to respond to a selection of the user input key performing the pre-determined function** (col. 3 line 55-67, wherein since the remote view has the same functionality as the local view, the printer responds the same way by performing the function of the button pressed).

Regarding claims 1, 5, 7, and 3, the structural elements of apparatus claims 20 and 21 perform all of the method steps of method claim 1, 5, 7, and 3 (respectively). Therefore method

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claims 1, 5, 7, and 3 are rejected for the same reasons as set forth in the rejection of apparatus claims 20 and 21.

Regarding claim 2, which depends from claim 1, Webb teaches **the printer is configured to perform a first function when the key is selected by a walk-up user and step (c) is performed by causing the printer to perform the first function** (col. 3 lines 55-67, col. 10 lines 60-67 and throughout).

Regarding claim 4, which depends from claim 1, Webb teaches in col. 10 line 41 that one of the many options that can be controlled and selected locally and remotely is paper size – **‘media having a different set of dimensions’**.

Regarding claim 6, which depends from claim 5, Webb teaches that the updates are in real time (col. 4 line 1) which reads on **‘presently being provided by the device’**.

Regarding claims 15 – 17, the structural elements of claims 20 and 21 perform all of the method steps of program claims 15 – 17. Further, Webb teaches the controller performs execution of a program to do so in col. 6 lines 56-67, including saving the program to a hard disk. Therefore, claims 15 – 17 are rejected for the same reasons as set forth in the rejection of apparatus claims 20 and 21.

Regarding claim 18, which depends from claim 15, Webb teaches that the two displays are virtually the same to the walk up user and the remote user (col. 3 lines 55 – col. 4 line 25, col. 7 lines 1-15)

Regarding claim 19, which depends from claim 15, Webb teaches that the whole display of the printer can be replicated (col. 3 lines 62-66) and that one of those items could be indicator lights (col. 6 line 30).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8 and 10 – 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Webb in view of Teng et al. (US 6327045).

Regarding claims 8 and 14, Webb teaches a **server** (col. 2 the paragraph of lines 10-16, wherein servers can be part of the LAN 21 of Fig. 1 as connected to the client and printer through the LAN), **comprising:**

(b) means for transmitting a program of computer readable instructions to the client (col. 6 lines 56-67, wherein program for completion the below functions is transmitted to the computer), **the program for enabling the client to:**

i) use a specific printer (16, Fig. 1) to print a document, the printer having a user input key (40a-d, 45, 46, Fig. 1); and

ii) automatically display (Fig. 1, 35') an image of the key (40a-d', 45', 46', Fig. 1) while the printer is printing the document (the status and control of the print job imply controlling the print job while it is being processed; and

iii) in response to receiving a user selection of the key image while the printer is printing the document, cause the printer to perform a particular function (col. 3 lines 55-67, col. 10 lines 60-67, Fig. 4, 200, col. 4 lines 5-9).

Webb clearly suggests using print and file servers for routing print jobs and providing files in the background of the invention. Web also teaches the system is implemented on a network through a LAN.

Webb does not specifically teach a web server that receives a html request and transmits the html code to the client for the client to control printing operations.

Teng teaches a client, server, printer system (Fig. 2) including receiving requests from the user and sending html to the user (Fig. 7) to control printing operations (Figs. 8 – 14).

It would have been obvious to one of ordinary skill in the art that the LAN/Server printing system of Webb could have been implemented in a Web printing system such as that of Teng. The motivations for doing so would have been to use all of the beneficial features of the Internet in the printing system and to provide for the user to even be more remote from the printer (for example, not in the LOCAL area network). Benefits of a printing system via the Internet are well known in the art.

Regarding claim 10, which depends from claim 8, Webb teaches that one of the functions that the panels perform is a **cancel** function in col. 2 line 59, as well as the stop function in Table I (col. 10) appears to perform the canceling function. Also, Teng shows canceling in Fig. 8.

Regarding claim 11, which depends from claim 8, Webb teaches in col. 10 line 41 that one of the many options that can be controlled and selected locally and remotely is paper size – ‘**media having a particular dimension**’. Teng shows it in Fig. 9.

Regarding claim 12, which depends from claim 8, Webb teaches that the two displays are virtually the same to the walk up user and the remote user (col. 3 lines 55 – col. 4 line 25, col. 7 lines 1-15)

Regarding claim 13, which depends from claim 8, Webb teaches **the client is a personal computer** (computer 11, Fig. 1) **connected to the server over a network** (Fig. 1, network 21).

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Webb and Teng as applied to claim 8 above, and further in view of Yoshida et al. (US 6130757).

Regarding claim 9, which depends from claim 8, while Teng teaches Web server (Fig. 2) for interacting with a client in a printing system, the combination does not specifically that the Web server is an embedded server in the printer.

However, it is known in the art, and Yoshida teaches, a printer that can act as a printer server or a printer client for controlling other network image forming devices, thus including

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image forming and print server related functions (multi-function device 1 as shown in Fig. 1; col. 4 lines 30-31, col. 9 lines 15-16, col. 9 line 1).


It would be obvious to one of ordinary skill in the art that the functionality of the server in the combination of Webb and Teng could have been implemented in a sophisticated printer such as that of Yoshida. The motivations for doing so would have been to reduce complexity by having all functionality needed at one device instead of two and it would allow image forming apparatuses to directly connect to the clients instead of having delays in transmission because of the data having to go through separate information processing apparatuses. Thus, the system is simplified by having less network and computing complexity and the system is faster by having the data on the network only transferred once and having internal (fast buses) connections between server and printing units instead of external (slower network transmission).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US-6678757, Paulus et al., 1-13-2004: teaches a print data management system and method, see specifically col. 6 lines 28-38.

US-6453127, Wood et al., 9-17-2002: teaches establishment at a remote location of an **Internet**/Intranet user interface to a copier/printer. Please review closely.


KING Y. POON
PRIMARY EXAMINER

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lucas Divine whose telephone number is 571-272-7432. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lucas Divine
Examiner
Art Unit 2624

ljd



KING Y. POON
PRIMARY EXAMINER